



Atty. Docket No. BET-00/1188

PATENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Steven BALL

Confirmation No. 4958

Serial No. 09/719,978

GROUP 1638

Filed April 25, 2001

Examiner Russell KALLIS

METHOD FOR OBTAINING MODIFIED  
POLYSACCHARIDES

RESPONSE

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Commissioner for Patents

TECH CENTER 1600/2900

Washington, D.C. 20231

Sir:

Responsive to the requirement for restriction set forth in the Official Action of July 3, 2002, Applicant hereby provisionally elects Group I, claims 1-6, 13-15 and 17-18, drawn to a nucleic acid encoding an  $\alpha$ -1,4 glucanotransferase, a method for modifying starch in a plant by transformation with a polynucleotide encoding an  $\alpha$ -1,4 glucanotransferase, with partial traverse. It is respectfully submitted that Group V, claims 12 and 16, should be examined with Group I. The grounds for traverse are as follows.

Group I relates to a method of modifying starch in a plant by transformation of a plant with a nucleotide sequence that modifies the activity of an  $\alpha$ -1,4 glucanotransferase enzyme. This group further concerns a nucleic acid encoding an  $\alpha$ -1,4 glucanotransferase enzyme. Group V relates to an  $\alpha$ -1,4 glucanotransferase enzyme. It is respectfully submitted that

Groups I and V are linked by the same inventive concept and that the method of Group I involves the modification of the enzyme of Group V.

The lack of unity determination set forth in the outstanding Official Action violates MPEP §1893.03(d), which requires that a lack of unity requirement not only list the different groups of claims, but also "explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group." While the outstanding Official Action contends that Groups I and V lack a special technical feature, the outstanding Official Action fails to provide an explanation for this contention.

A determination of a lack of unity is possible only when the claims of the different groups lack a "special technical feature" relative to one another. Thus, the Patent Office has the burden to establish the lack of a special technical feature, which the outstanding Official Action plainly does not do.

In addition, the Examiner's attention is respectfully directed to PCT Rule 13.2 in part I(b) of annex B of the Administrative Instructions under the PCT, which specify that "special technical features" as defined as meaning those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art. Thus, absent a showing that the special technical features are present in a prior art reference, no determination of lack of

unity could properly be made. As the outstanding Official Action fails to show that there is no special technical feature that links the nucleic acid encoding an  $\alpha$ -1, 4 glucanotransferase of Group I with the protein having an  $\alpha$ -1, 4 glucanotransferase of group V, it is respectfully submitted that the restriction requirement is improper.

In light of the above discussion, it is believed to be apparent that the lack of unity determination set forth in the Official Action of July 3, 2002 is improper and must be withdrawn. Favorable action on the merits of the claims set forth in Groups I and II is therefore respectfully requested.

Respectfully submitted,

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